

R E M A R K S

Claims 1, 3-15 and 17-36 are pending in the present application.

The Examiner has required election in the present application between:

Group I, Claims 2, 5-9, 11-14, 18, 20-27 and 31-36, drawn to a method of performing a one-pot organic reaction, wherein the non-catalysing solid CO releasing metal compound is a metal carbonyl of formula I;

Group II, Claims 3-6, 10 and 28-30, drawn to a method of performing a one-pot organic reaction, wherein the non-catalysing CO releasing metal compound is a formamide of formula II;

Group III, Claims 15-16, 18 and 35-36, drawn to a method of preparing a chemical library with a non-catalysing solid CO releasing metal carbonyl of formula I;

Group IV, Claim 17, drawn to a method of preparing a chemical library with a non-catalysing CO releasing formamide of formula II;  
and

Group V, Claim 19, drawn to a kit.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, claims 2, 5-9, 11-14, 18, 20-27 and 31-36; drawn to a method of performing a one-pot organic reaction, wherein the non-catalyzing solid CO releasing compound is a metal carbonyl of formula I.

However, Applicants further request rejoinder of the claims of Groups III (claims 15-16, 18 and 35-36, drawn to a method of preparing a chemical library with a non-catalysing solid CO releasing metal carbonyl of formula I) and V (claim 19, drawn to a kit containing a a non-catalysing solid CO releasing metal carbonyl of formula I). The claims of Groups I and III have been improperly restricted from one another, since these claims share a common technical feature of the reaction using a non-catalysing solid CO releasing compound of metal carbonyl of formula I. Claim 19 has been amended to similarly share this common technical feature, therefore should also be rejoined.

The Examiner further required the following elections of species.

- 1) A single compound of formula I, if Group I or Group III is elected, or of formula II, if Group II or Group IV is elected.
- 2) A single metal catalyst.
- 3) A single non-metal substrate.

4) A single energy source.

Applicants traverse this election of species and withdrawal thereof is respectfully requested. Applicants believe that the election of species is improper under the clear direction of 37 C.F.R. §1.146 "Election of Species", which states

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, **the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable.** However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application. (emphasis added)

Thus, under 37 C.F.R. §1.146, the Examiner may only require an election of species if the generic claim is not found allowable. No determination of the allowability of the generic claim has been found yet, thus an election of species is improper.

Alternatively, the Examiner may require an election of species if the claims recite an unreasonable number of species. However, the number of species of compounds of formula (I) recited in claim 8; metal catalysts recited in claim 12 and energy sources recited in claim 18, respectively, is not unreasonable. For example, claim 8 recites only five species of compounds of formula (I). If the

Examiner considers five species unreasonable, then the purpose of 37 C.F.R. 1.146 would be completely eviscerated because it would seem that any number of species more than one or two would be considered "unreasonable." Similarly, claim 18 recites only five energy sources. Claim 12 recites 22 possible metal catalysts; however the species of catalysts fall within only six types of structurally related catalysts, i.e. Pd-based, Pt-based, Ni-based, Rh-based, Co-based and Ir-based.

As such, the requirement for an election of species is improper under the Rules, and withdrawal of the election of species is respectfully requested.

In the event that the Examiner does not withdraw the election of species, Applicants elect, with traverse, the following species to begin examination. Should the elected species be found allowable, the Examiner is requested to expand the search and examination to the rest of the recited species of the claims.

- 1) A single compound of formula I = **Mo(CO)<sub>6</sub>**
- 2) A single metal catalyst = **Pd**
- 3) A single non-metal substrate = **Applicants again note that it is not possible to elect a single non-metal substrate because there is no claimed list of such non-metal substrates from which to make an election.**
- 4) A single energy source = **microwave energy**


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants request a one (1) month extension of time for filing the present response. The required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Gerald M. Murphy, Jr., #28,977

MaryAnne Armstrong, PhD., #40,069

GMM/MAA:bmp  
1209-0129P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000